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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,682	06/11/2001	Limor Schweitzer	XACTP005	5002

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EXAMINER
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APPLE, KIRSTEN SACHWITZ

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 03/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/879,682	<b>Applicant(s)</b> SCHWEITZER, LIMOR	
	<b>Examiner</b> Kirsten S. Apple	<b>Art Unit</b> 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/11/201 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/22/02, 1/23/06, 7/27/01</u> | 6) <input type="checkbox"/> Other: _____  |

## Detailed Action

This action is in response to the application filed on 06/11/2001.

### *Priority*

Acknowledgment is made of applicant's claim for prior priority date of U.S. Provisional Patent Application 60/210,966 filed on 06/12/2000.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 7, 15 & 35 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

#### **Re claim 7:**

*Transferring the payment from a pervious debit account before enabling the debit account in response to the request.*

It is unclear to the examiner what the "previous debit account" is. For the purposes of examination the claim will be interpreted as:

"Transferring the payment from the debit account in response to the request."

#### **Re claim 15:**

*Another user may engage in the wireless network voice communication and the IP usage upon receipt of the key*

It is unclear to the examiner what the "engage in wireless network" is. For the purposes of examination the claim will be interpreted as:

*User may authorize payment of another users wireless network voice communication and IP usage upon receipt of the key by said user*

**Re claim 35:**

*Logic for ....*

The systems claim does not appear to have any physical element to be considered as part of the claimed system. For the purposes of examination the claim will be interpreted as:

*"Mean for..." (instead of "logic for..."*

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 18-35 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In particular, at least the independent claims recite a "computer program." The MPEP section 2106 (page 2100-13 of MPEP version 8) clearly outlines "Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer."

Corrective action to Claims 18-35 is required.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

Art Unit: 3628

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11 & 18-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hultgren (U.S. Patent 6,88,391) in view of official notice.

**Re claim 1 & 18:** Hultgren discloses:

*A method and program for providing a digital wallet for IP usage utilizing a wireless network, comprising:*

*Receiving a request for a debit account* (Hultgren, Figure 3A, Item 300)

*Enabling debit account* (Hultgren, Figure 3A, Items 306, 314 & 316)

*Collecting payment over wireless network billing debit account* (Hultgren, Figure 3B, Item 328)

*Collecting payment against debit account with IP over wireless network* (Hultgren, Figure 3B, Item 330)

Although Hultgren does specifically disclose payment for mobile phone usage a the examiner reference official notice that a mobile phone company is a utility. Hultgren specifically uses the example of “utility bill, for example” (column 4, line 50)

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to add mobile phone usage payment for utility bill payment.

It is clear that one would be motivated to maximize the number of merchant's available.

**Re claim 2 & 19:** Hultgren discloses:

*Request received via mobile cellular hand set and debit account is enabled by human operator* (Hultgren, Figure 1, Item 60)

**Re claim 3 & 20:** Hultgren discloses:

*Wireless network via a mobile cellular handset* (Hultgren, Figure 1, Item 50)

**Re claim 4 & 21:**

*Uses WAP*

The examiner submits official notice that it is well known to one of ordinary skill in art at the time of the invention that WAP is a commonly used protocol for developing wireless applications and could be used for developing a mobile payment system.

**Re claim 5 & 22:** Hultgren discloses:

*IP includes data transfer* (Hultgren, Figure 1, Item 50)

**Re claim 6 & 23:** Hultgren discloses:

*IP usage includes payment for good or services* (Hultgren, Figure 3)

**Re claim 7 & 24:** Hultgren discloses:

*Transferring the payment from the debit account in response to the request* (Hultgren, Figure 3A, Items 306, 314 & 316)

**Re claim 8 & 25:** Hultgren discloses:

*Balance is updated in real-time* (Hultgren, column 9, line 36-47, “immediately transfer funds”)

**Re claim 9 & 26:** Hultgren discloses:

*Alert is sent to a user when below predetermined amount ??* (Hultgren, column 7, line 40-47, “invalid transaction notification”)

**Re claim 10 & 27:** Hultgren discloses:

*Discontinued usage upon the debit account falling below a predetermined amount*  
(Hultgren, Figure 3A, Items 318)

Art Unit: 3628

**Re claim 11 & 28:** Hultgren discloses:

*Payment is received via a credit account* (Hultgren, Figure 3A, Items 306, 314 & 316)

**RE: Claims 12-15 & 29-32**

Claims 12-15 & 29-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hultgren (U.S. Patent 6,88,391) in view of official notice in further view of Foladare (U.S. Patent 5,914,472.)

**Re claim 12 & 29:** Foladare discloses:

*Limiting usage based on user-defined threshold* (Foladare, Figure 1, Item 104)

Hultgren & official notice describe a wireless payment process as described in Claim 1. However, Hultgren & official notice does not specifically disclose user-defined threshold. Foladare specifically defined this. (Foladare, Figure 1, Item 104)

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to add user-defined threshold as taught by Foladare to previous references.

It is clear that one would be motivated to add flexibility to the process.

**Re claim 13 & 30:** Foladare discloses:

*Threshold expires after a pre-determine time limit*

The examiner submits official notice that it is well known to one of ordinary skill in art at the time of the invention that any variable set by the user can have time limits associated with it. This is just good business practice to never have user inputs without time limitations on these inputs.

**Re claim 14 & 31:** Foladare discloses:

*User-defined threshold limitation expires upon receipt of a key* (Foladare, Figure 1, Item 116, authorization – either through a key or other method)

Hultgren & official notice describe a wireless payment process as described in Claim 1. However, Hultgren & Official Notice does not specifically disclose user-defined threshold limitation. Foladare specifically defined this. (Foladare, Figure 1, Item 104)

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to add user-defined threshold limitation as taught by Foladare to previous references.

It is clear that one would be motivated to add flexibility to the process.

**Re claim 15 & 32:** Foladare discloses:

*User may authorize payment of another users wireless network voice communication and IP usage upon receipt of the key by said user* (Foladare, Abstract, “ancillary credit or debit card”)

Hultgren & official notice describe a wireless payment process as described in Claim 1. However, Hultgren & Official Notice does not specifically disclose user key. Foladare specifically defined this. (Foladare, Figure 1, Item 104)

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to add user key as taught by Foladare to previous references.

It is clear that one would be motivated to add flexibility to the process.

**RE: Claims 16-17 & 33-34**

Claims 16-17 & 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hultgren (U.S. Patent 6,88,391) in view of official notice in further view of Foladare (U.S. Patent 5,914,472) in further view of Holm-Blagg (US PG Published 2004/0030657 A1)



**Re claim 16 & 33:** Holm-Blagg discloses:

*Plural users may use wireless network voice communication and IP using a single debit account (Holm-Blagg, Figure 2, account 1 & 5, etc)*

Hultgren & official notice describe a wireless payment process as described in Claim 1. Additional, Foladare discloses parent-child credit card relationship. However, Hultgren, Official Notice & Foladare does not specifically describe plural users. Holm-Blagg clearly discloses a plurality of users. (Holm-Blagg, Figure 2, account 1 & 5, etc)

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to add plurality of users as taught in Holm-Blagg to previous references.

It is clear that one would be motivated to add flexibility to the process.

**Re claim 17 & 34:** Holm-Blagg discloses:

*Limiting the usage for each of the users based on a single threshold associated with the debit account (Holm-Blagg, Figure 7B, "available credit line")*

Hultgren & official notice describe a wireless payment process as described in Claim 1. Additional, Foladare discloses parent-child credit card relationship. However, Hultgren, Official Notice & Foladare does not specifically describe a plurality of users. (Holm-Blagg, Figure 2, account 1 & 5, etc)

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to add plurality of users as taught in Holm-Blagg to previous references.

It is clear that one would be motivated to add flexibility to the process.

***Contact Information***

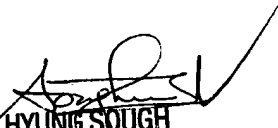
Art Unit: 3628

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kirsten S. Apple whose telephone number is 571.272.5588. The examiner can normally be reached on Monday - Friday 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sam Sough can be reached on 571.272.6799. The fax phone number for the organization where this application or proceeding is assigned is 571-272-6126.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ksa

  
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